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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,864	06/11/2001	Mark Nordlicht	20014380-0005	2664
7278	7590	10/04/2007	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			AKINTOLA, OLABODE	
			ART UNIT	PAPER NUMBER
			3691	
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			10/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/878,864

Applicant(s)

NORDLICHT, MARK

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32, 34, 35, 39 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) 45, 46 and 53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32, 34, 35, 39, 44 and 47-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/27/2007.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claim 45 (Invention II) and claims 46 and 53 (Invention III) are directed to inventions that is independent or distinct from the invention originally claimed for the following reasons:

Invention I (Claims 32, 34-35, 39, 44, 47-52), Invention II (Claims 1-2, 5-15) and Invention III (Claims 22-29) are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01). In the instant case, the different inventions have different modes of operation and/or functions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-46 and 53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3691

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 32, 34-35, 39, 44 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (USPN 5136501) ("Silverman") in view of Ganesan et al (USPAP 20020087471) ("Ganesan").

Re claims 32, 44, 48 and 50: Silverman teaches a method, comprising the steps of: at a first client device connected to a network, transmitting an offer to conduct the transaction that is received by a second client device connected to the network (Abstract, Fig1); at the second client device, transmitting an acceptance of the offer to conduct the transaction (col. 12, lines 41-43; col. 13, lines 41-60); determining whether a predetermined condition is met (col. 3 line 52 thru col. 4, line 5).

Silverman does not explicitly teach automatically changing the transaction from a first market type to the second market type upon determining that the first predetermined condition is met.

Ganesan teaches automatically changing the transaction from a first market type to the second market type upon determining that the first predetermined condition is met (sections 0028, 0045,

Art Unit: 3691

claims 18, 41 and 49). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Silverman to include this step as taught by Ganesan. One would have been motivated to do so in order to accept qualifying payment only based on payer's credit risk.

Re claim 34: Silverman teaches clearinghouse exchange market (col. 4, lines 64-65, col. 9, line 40)

Re claims 35 and 47: Silverman teaches credit exchange market (col. 22, lines 1-10)

Re claim 39: Silverman teaches automatically generating a user prompt at the first client device when the predetermined condition is met, the user prompt being generated for a user of the first client device to manually restrict the transaction to be a transaction of the first market type (col. 3, lines 52 thru col. 4, line 5).

Re claim 49: Silverman teaches wherein the predetermined condition is based on the identities of entities participating in the transaction (col. 3, lines 52 thru col. 4, line 5).

Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman in view of Ganesan/Heilman, JR (USPAP 20010034689) ("Heilman").

Re claim 51 and 52: Silverman does not explicitly teach wherein the predetermined condition is the user identifier is absent from the list located on the first client device. Ganesan teaches list of preferred payees (sections 0105, 0114). Heilman teaches wherein the predetermined condition is the user identifier is absent from the list located on the first client device (sections 0015, 0072). It

Art Unit: 3691

would have been obvious to one of ordinary skill in the art at the time of the invention to modify Silverman to include this step as taught by Heilman. One would have been motivated to do so in order to facilitate specific transactions with pre-approved counterparties meeting pre-defined parameters only.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wiseman (USPN 5168446) teaches a system for conducting and processing spot commodity transactions.

Shepherd (USPN 5970479) teaches a method and apparatus relating to the formulation and trading of risk management contracts.

Chenevich et al (USPAP 20020111886) teaches a payment management.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI
PRIMARY EXAMINER